

R.R. Wile
195-28 37 Ave
F/40 27

Materials located at the Federal Archives and Record
Center, Waltham, Mass., 02154 (Record Group 21)

U. S. Circuit Court.
District of Connecticut.

Edison Phonograph Co., Complainant) In Equity, No. 759
versus)
Thomas H. MacDonald, Defendant) On Patent No. 382,416

Partial Record

Note: This case was one of a series of cases brought on
fundamental Edison phonograph patents. A Bill of Complaint
was filed, Answers were prepared but little else was

done to push the case and cases. It was used as a trade off
in the American Graphophone Co. vs, Edison Phonograph Works
case. Edison agreed to a consent decree and MacDonald and
American Graphophone agreed to consent decrees.

The full group of Connecticut cases is as follows:

No. 759	382,416	Feed and Return mechanism
No. 760	386,974	Comprehensive phonograph patent
No. 761	393,966	Method of recording and reproducing sound
No. 762	393,967	Recording and reproducing sound.
No. 763	393,968	Phonograph recorder
No. 764	400,646	Recorder and reproducer
No. 765	400,647	Use of reproducer point slightly narrower than record groove.
No. 766	430,278	Reproducer, reproducer point and method of connecting the diaphragm
No. 767	484,583	Cup-shaped recorder needle.
No. 769	499,879	Numerous improvements on the phonograph, phonograph motors and phonograph governors

Nos. 759 thru 767 were filed on June 8, 1893, No. 769
was filed on June 29, 1893 slightly after the issue of the patent.
All cases were settled and consent decrees entered on Dec. 11, 1896
thus upholding the validity of the Edison patents. American Graphophone
and the Edison groups had agreed on December 7th to cross-license
one another.

No 759

U. S. Circuit Court
Dist. of Connecticut
IN EQUITY.

Patent No 382,416

EDISON PHONOGRAPH COMPANY,

Complainant,

vs.

Thomas H. Mac Donald

Defendant.

BILL OF COMPLAINT.

DYER & SEELY,

Solicitors for Complainant,

36 WALL STREET,

New York City.

Federal Archives
+ Record Center
Washington, Mass
02154

To the Clerk of the

You will please issue a subpoena to the Defendant

in the above entitled cause, returnable

Filed June 9 1893

C. G. Burgoyne, Walker and Centre Sts., N. Y.

Final Decree Dec 11. 1896

1
The United States Circuit Court
for the District of Connecticut
2nd Circuit.

THE EDISON PHONOGRAPH COMPANY,
Complainant,

vs.

Thomas H. Mac Donald

Defendant

2
In Equity.

TO THE HONORABLE THE JUDGES OF THE ^{Circuit}
Court of the United States for the
District of Connecticut 2nd Circuit.

THE EDISON PHONOGRAPH COMPANY, a corporation
organized and existing under and by virtue of the laws
of the State of New Jersey, and doing business at
Orange, in said State and elsewhere, brings this its bill
of complaint against

4
Thomas H. Mac Donald
resident in the District
of Connecticut.

5 And, thereupon, your orator complains and says, on information and belief, that Thomas A. Edison, at that time residing at Llewellyn Park, in the County of Essex and State of New Jersey, before and at the time of his application for the hereinafter mentioned letters patent, was a citizen of the United States, and was the true, original and first inventor of a certain new and useful improvement in

6 *Feed and Return
Mechanisms for
Phonographs*

7 fully described in the specification of the letters patent hereinafter mentioned, and which had not been known or used in this country and had not been patented or described in any printed publication in this or any foreign country prior to his invention or discovery thereof, and which had not been for more than two years prior to his application for a patent, as hereinafter mentioned, in public use or on sale, and had not been abandoned to the public.

8 And your orator, on information and belief, further shows that Thomas A. Edison, being so as aforesaid the first inventor and discoverer of said Improvement in

*Feed and Return
Mechanisms for
Phonographs.*

did on the *eighth day of May 1888*

upon due application therefor, obtain Letters Patent of the United States for said invention in due form of law under the seal of the Patent Office of the United States, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents of the United States, bearing date the day and year last aforesaid, and numbered

382,416

10

whereby there was granted and secured to the said Thomas A. Edison, his heirs, executors, administrators or assigns, for the term of seventeen years from and after the date of said letters patent, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention and improvement as set forth in said letters patent, as will appear by said letters patent, or a duly authenticated copy thereof, ready in court to be produced.

11

And your orator further shows unto your Honors that by virtue of an instrument in writing dated the 27th day of July, 1888, the said Thomas A. Edison and another duly assigned, transferred and set over unto the complainant herein the said letters patent granted to Thomas A. Edison as aforesaid, and all right, title and interest in and to the same, ~~and all rights of action or claims for damages or profits arising out of the said patent rights~~ as will more fully appear by said assignment or a duly authenticated copy thereof in court to be produced.

12

And your orator further shows unto your Honors that by virtue of the premises it became, and now is, the sole and exclusive owner of said letters patent, granted to Thomas A. Edison as aforesaid, together with the invention and discovery described and claimed in said letters patent, and of all the rights and privileges granted and secured, or intended to be granted and secured thereby.

And your orator further shows unto the Court that

- 13 its predecessors in the title of said patent whose rights it has acquired as aforesaid, together with itself since it became the owner of the said patent as aforesaid, have invested and expended large sums of money, and have been to great trouble in and about the said invention, and for the purpose of introducing the same into use and making the same profitable to themselves and useful to the public, and that said invention has been and is of great benefit and advantage to your orator and the public, and that the public have
- 14 generally acknowledged and acquiesced in the aforesaid rights of your orator, and your orator believes that it will realize and receive large gains and profits therefrom, if infringements by said defendant and confederates shall be prevented.

- Yet the defendant, well knowing the premises and the rights secured to your orator aforesaid, but contriving to injure your orator, and to deprive it of the benefits and advantages which might and otherwise would accrue unto it from said invention, after the granting
- 15 of the said letters patent aforesaid, and before the commencement of this suit, did, as your orator is informed and believes, at

*the city of
Bridgeport in the State
of Connecticut and
elsewhere*

16

- without the license, and against the will, of your orator, and in violation of its rights and in infringement of the
- ✓ aforesaid letters patent, unlawfully and wrongfully, and in defiance of the rights of your orator, did make, and did use and did sell and did cause to be made and did

caused to be used and did cause to be sold and used 17

apparatus and mechanisms

containing the improvement described and claimed in the aforesaid letters patent or material and substantial parts thereof, and that the said defendant has made, sold and used the said apparatus, and that *he* still continues so to do, and that

he is threatening to continue the aforesaid unlawful acts to a large extent, all in defiance of the rights acquired by and secured to your orator as aforesaid, and to its great and irreparable loss and injury, and by which it has been and still is being deprived of great gains and profits which it might and otherwise would have obtained, but which have been received and enjoyed, and are being received and enjoyed, by the said defendant and by and through *his* aforesaid unlawful acts and doings.

18

And your orator further shows unto your Honors, on information and belief, that said defendant has had notice of said infringements, and of the rights of your orator in the premises, but has disregarded said notice, and refused to desist from said infringements, and still continues so to do.

19

And your orator further shows unto your Honors, on information and belief, that said defendant has made, sold and used large numbers of the apparatus described in said patent, and has realized large profits and advantages from said infringement, but to what extent, and how much exactly your orator does not know, and prays a discovery thereof. And your orator says

20

and preparation for and avowed determination to continue the same and other aforesaid unlawful acts, in disregard and defiance of the rights of your orator, have the effect to encourage and induce others to venture to infringe said patent in disregard of your orator's rights.

And your orator prays that said defendant

21

Thomas N. Mac Donald
his

- 22 servants, agents, attorneys, employees, workmen and confederates, and each and every of them, may be perpetually restrained and enjoined by the order and injunction of this Honorable Court from directly or indirectly making, constructing, using, vending, delivering, working or putting into practice, operation or use, or in anywise counterfeiting or imitating the said invention or any material or substantial part thereof, or any apparatus made or operated in accordance therewith, or like or similar to those which heretofore made, used and sold, and that the said defendant may be decreed to
- 23 pay the costs of this suit, and that your orator may have such further relief as to this Honorable Court shall seem meet, and as shall be agreeable to equity.

- May it please your Honors to grant unto your orator the writ of injunction issuing out of and under the seal of this Honorable Court, commanding, enjoining and restraining the said defendant *his* servants, agents, attorneys and workmen, and each and every of them, during the pendency of this suit, as is herein-
- 24 before in that behalf prayed in regard to said perpetual injunction.

And forasmuch as your orator can have no adequate relief except in this Court, to the end, therefore, that the said defendant may, if *he* can, show why your orator should not have the relief hereby prayed, and may, but not upon oath (the oath being expressly waived), according to *his* best and utmost knowledge, remembrance, information and belief, full, true, direct and perfect answers make to the premises, and to all the several matters hereinbefore stated and charged,

as fully and particularly as if severally and separately in- 25
 terrogated as to each and every of said matters, and
 may be compelled to account for and pay to your
 orator the profits by *him* acquired, and the damages
 suffered by your orator from the aforesaid unlawful
 acts; and that the Court may assess said profits and
 damages, and may increase the damages to a sum not
 exceeding three times the amount thereof.

May it please your Honors to grant unto your orator
 the writ of subpoena issuing out of and under the seal
 of this Honorable Court, directed to the said defend- 26
 ant

Thomas N Mac Donald

27

commanding *him* by a certain day and under a cer-
 tain penalty to be and appear in this Honorable Court,
 then and there to answer the premises, and to stand
 to and abide such order and decree as may be made
 against *him*.

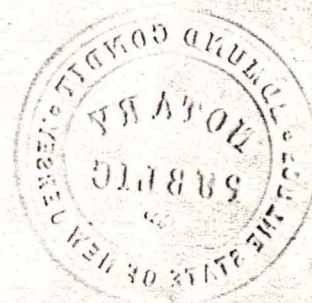
And your orator will ever pray, etc.

Eaision Phonograph Company
by John B. Randolph

Secretary

By [Signature]
 Complainant's Solicitor. S

36 Wall St
New York



29 UNITED STATES OF AMERICA, } ss. :
 State, ~~City and County of New York,~~ }
~~New Jersey~~ *Essex.*

On this *6th* day of *June*, 19*93*, before
 me personally appeared ~~Alfred C. Tate~~ *John R. Randolph*, who, being by
 me duly sworn, did depose and say that he is the sec-
 retary of the Edison Phonograph Company, the com-
 plainant herein; that he has read the foregoing bill of
 complaint subscribed by him and knows the contents
 thereof, and that the same is true of his own knowl-
 30 edge, except as to the matters therein stated to be
 alleged on information and belief, and as to those mat-
 ters he believes it to be true.

John R. Randolph.

31 *Edmund Condit*
Notary Public J.R.F.

32

[5510]



No 769

U.S. Circuit Court
District of Conn

Edison Phonograph Co.

vs

Thos. A. MacDonald

Answer

Filed Oct 3, 1893

E. C. Mason
clerk

IN THE UNITED STATES CIRCUIT COURT FOR THE
DISTRICT OF CONNECTICUT,
all said improvement was not in the 2nd Circuit.

The Edison Phonograph Co.,)
vs.) In Equity.
Thomas H. MacDonald.)
-----)
No. 759.

The answer of Thomas H. MacDonald, of Bridgeport,
Connecticut, to the Bill of Complaint of the Edison Phono-
graph Company, complainant in the above entitled cause.

This defendant, further answering upon information
This defendant now and all times hereafter saving
and reserving to himself all manner of benefit of exception
that can or may be had or taken to the manifold errors,
uncertainties, imperfections and insufficiencies in said bill
contained, for answer thereunto, or unto so much and such
parts thereof as he is advised it is material or necessary
for him to make answer unto, answerings says:

1. Upon information, advice and belief this defendant
admits that Letters-patent of the United States, Numbered
382,416 were issued on the eighth day of May 1888, for an
alleged improvement in Feed and Return Mechanism for Phono-
graphs, to Thomas A. Edison, as in said bill of complaint
alleged, but denies that said Edison was the true, original and
first inventor of said alleged improvement, and denies that
said improvement was not known or used by others in this
country and not patented or described in any printed publica-

tion in this or any foreign country prior to the alleged invention thereof by said Edison, and denies that the said alleged improvement was not in public use or on sale in the United States for more than two years prior to the application for said patent, and denies that said Edison duly made application for said Letters-patent or that the same were duly issued and delivered in accordance with the law.

2. Touching the alleged grant of the entire right, title and interest in and to said Letters-patent to the said Complainant, this defendant is not informed save by said bill of complaint, and therefore upon advice he denies the allegation of the bill in this particular and prays that the complainant be required to make strict proof thereof. in

3. ~~at~~ This defendant, further answering upon information and belief, denies that the alleged invention described in said Letters-patent is of great benefit or advantage to the complainant or to the public or that the public have acquiesced in the alleged rights of the complainant, or that the complainant or its predecessors in the title of said Letters-patent has or have expended large sums of money and been to great trouble in and about said invention.

4. This defendant, further answering upon information, belief and advice, denies that he has made, used, or sold or caused to be made, used or sold, apparatus or mechanisms containing any improvement secured to the complainant by or under the said Letters-patent, or ~~has~~ or has received or obtained any profits whatever which of right should have been received and obtained by the said complainant, or that the complainant has suffered any loss or injury, or been deprived of any gains or profits by reason of such alleged use, or that he has in any manner whatsoever infringed upon any rights

of the complainant in the premises. the United States, in view

5. And this defendant denies that he has ever been notified of the pretended rights of the complainant under said Letters-patent or that he was infringing the same.

6. And this defendant, further answering upon information and belief, denies that said Thomas A. Edison is the true, original and first inventor of any improvement or invention described in said Letters-patent, and denies that said Letters-patent describe, or set forth any invention or improvement patentable under the laws of the United States, and on the contrary avers that, before the alleged invention, or any invention thereof by said Edison, the same or substantially the same things, or material parts thereof, were described in said of divers Letters-patent of the United States and foreign countries and in printed publications and particularly in the following:

Letters-patent of the United States to-
Tainter No. 385,866, dated July 10, 1888,
" No. 341,288, dated May 4, 1886,
Barnes, No. 357,367, dated February 15, 1887,
Ballou, dated March 15, 1887, No. 359,381,
" " No. 359,377.

And in many other patents and printed publications, the dates and titles whereof this defendant cannot now state, but prays leave to add the same to this answer by amendment or otherwise when he shall have fully ascertained the same.

7. And further answering upon information, advice and belief, this defendant avers that the said Letters-patent are null and void and of no effect in law, for the reason that the improvement described or set forth therein was and is not a patentable invention, or susceptible of being the subject

of Letters-patent under the laws of the United States, in view of the common knowledge of persons skilled in the art to which said alleged improvement relates, and in view of the then existing state of such art as shown by the patents and publications herein before referred to, and of others of like nature herein in Court to be produced and proven?

And this defendant craves the same benefit of the several matters and things herein above set forth, as if the same had been specially pleaded where a plea would have been proper, or as if on account thereof he had demurred in due form to said bill or parts thereof, where a demurrer would have been proper.

Without this, that any other matter or thing in said bill contained material or necessary for this defendant to make answer unto, and not herein and hereby well and sufficiently answered, traversed, confessed and avoided, is true to the knowledge, information or belief of this defendant, all which matters and things this defendant is ready and willing to aver, maintain and prove, as this Honorable Court shall direct and hereby prays to be hence dismissed with his costs and charges in this behalf most wrongfully sustained.

Lee Lee
Solicitors for Defendant
John Mawes,
of counsel.

IN THE UNITED STATES CIRCUIT COURT FOR THE
State of *Connecticut*)
County of *Fairfield*) s.s:
)
)

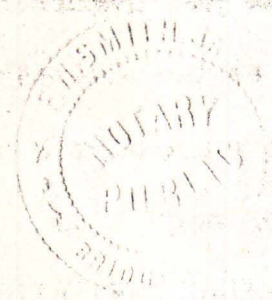
Thomas H. MacDonald, being duly sworn, deposes and
says that he is the defendant above named; that he has read
the foregoing answer and knows the contents thereof, and that
the said answer is true of his own knowledge save as to
matters therein stated on information, advice and belief,
and as to such matters he believes it to be true.

Thomas H. MacDonald

Sworn to and subscribed before me this 2nd day of
~~October~~
~~August~~ 1893.

W. W. Smith

Notary Public.



No 459
UNITED STATES CIRCUIT COURT,
District of Connecticut.
In Equity. ~~1896~~.

THE EDISON PHONOGRAPH COMPANY,

vs.

THOMAS H. MacDONALD.

FINAL DECREE

On Patent No. 382,416.

Dyer & Driscoll,
For Complainant,
36 Wall Street,
New York, N.Y.

Filed Dec 11. 1896
C. C. Martin
Att'y

AT A STATED TERM of the United States Circuit Court for the District of Connecticut, in the Second Circuit, held at the United States Court Rooms in the City of Hartford, on the 11th day of December, one thousand eight hundred and ninety-six;

P R E S E N T :

Nathaniel Shipman
Hon. ~~Nathaniel Shipman~~,

Circuit Judge.

.....
THE EDISON PHONOGRAPH COMPANY,

vs.

THOMAS H. MacDONALD.

: In Equity. NO. 759.

: On Patent No. 382,416.

.....
This cause having come on to be heard, it is
ORDERED, ADJUDGED AND DECREED as follows:

That Letters Patent of the United States, No. 382,416, granted May 8, 1888, to Thomas A. Edison, for feed and return mechanism for phonographs, are good and valid Letters Patent; that the complainant, The Edison Phonograph Company, was at the time of the filing of the bill of complaint herein, possessed of the full and entire right, title and interest in and to the same, and that the defendant, Thomas H. MacDonald, has infringed upon said Letters Patent, and upon the exclusive rights of the complainant under the same.

IS IS FURTHER ORDERED, ADJUDGED AND DECREED that the complainant recover of the defendant the profits which the latter has received or which have accrued to him from said infringement by the manufacture, use and sale of the improvement described in said Letters Patent, and in addition thereto the damages which the complainant has sustained thereby;

And it being agreed by the parties that a reference

to the Master be waived, and that the profits and damages to be recovered by the complainant of the defendant in said cause be assessed at the sum of one dollar, it is further

ORDERED, ADJUDGED AND DECREED that the complainant recover of the defendant the sum of one dollar, as damages and profits by reason of said infringement, that judgment be entered for said sum and execution issue thereon;

IT IS FURTHER ORDERED, ADJUDGED AND DECREED that a perpetual injunction issue against the defendant in accordance with the prayer of the bill.

W. K. Pounsford

Circuit Judge.

We hereby consent to the entry and filing of the above decree.

Wm. & Seely

Complainant's Solicitors.

Lees Lee

Defendant's Solicitors.

G. P. Rodman
of counsel